

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed September 22, 2004. At the time of the Office Action, Claims 1-70 were pending in the Application. The Examiner entered a Restriction Requirement for the pending Application. Applicant has elected to prosecute Claims 1-65 and to withdraw Claims 66-70 without prejudice or disclaimer for future prosecution in a Divisional Application. Applicant reserves the right to comment on such an election and/or on the appropriateness of the Restriction Requirement at a future time should Applicant deem it appropriate to do so. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

In the Drawings

The Application was filed with informal drawings that are acceptable for examination purposes. Formal drawings for the Application have been appended to this Response. Applicant submits that the formal drawings do not add any new matter to the Application and are in full compliance with 37 C.F.R. §1.81, §1.83, and §1.84.

Section 103 Rejection

The Examiner rejects Claims 1, 10-11, 20-21, 30-31, 40-46, 48-54, 56-62, and 64 under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 6,785,228 issued to Vandette (hereinafter "*Vandette*"). This rejection is respectfully traversed for the following reasons.

The Examiner is respectfully reminded that he has failed to satisfy each of the elements of non-obviousness, which are required to support a proper §103 analysis. According to M.P.E.P. §2143, to establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to combine the references. Second, there must be a reasonable expectation of success. Third, the prior art combination of references must teach or suggest all the claim limitations.<sup>1</sup> As an initial matter, the Examiner has failed to meet his burden with respect to the third criteria of non-obviousness.

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<sup>1</sup> See generally M.P.E.P. §2143.

Independent Claim 1 recites:

A method for providing service trigger management in a wireless network, comprising:  
generating at an application of a mobile unit a current request for a network session; and  
determining allowability of the session based on a service agreement without accessing external resources.

In contrast to the teachings of Independent Claim 1, *Vandette* discloses a subscriber permission and restrictions system for switched connections. The system fails to recite any subject matter that relates to wireless communications. The Examiner concedes this point, but fails to offer any additional disclosure or reference to supply such a teaching. (See Current Office Action: page 4.) Thus, instead of providing the absent teaching, the Examiner has taken judicial notice for this missing element. Applicant respectfully reminds the Examiner that such a liberal usage of judicial notice is simply improper, as outlined in greater detail below.

The Examiner has not shown a suggestion or a motivation in the references or in the knowledge generally available to one of ordinary skill in the art to combine the cited reference. The mere fact that a reference can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of making the combination.<sup>2</sup> Thus, the fact that the teachings of one reference (*Vandette*) could improve a theoretical architecture, as posited by the Examiner, does not provide the required suggestion to make such a combination. Nothing in *Vandette* or in any other reference suggests or motivates the proposed combinations. Nor has the Examiner provided any evidence that suggests any of the proposed modifications. If the Examiner is only relying on “common knowledge” or on “well known” art in support of his rationale for using judicial notice in the context of *Vandette*, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. §2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to combine, Applicant respectfully requests that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. §2144.03.

The Examiner merely speculates, “it would have been obvious” to make the proposed combination. The Examiner is merely interjecting a subjective conclusory statement in an

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<sup>2</sup> See M.P.E.P. §2143.01.

improper hindsight attempt at rejecting the claims without citing any language from any of the cited references to support the rejection. The Examiner presents no objective evidence from the prior art that suggests or motivates the combination as is required by Federal Circuit case law.<sup>3</sup> The M.P.E.P. also confirms that this approach is improper and, thus, it should not be used here.<sup>4</sup>

Furthermore, the Examiner is precluded from modifying the teachings of *Vandette* in an effort to teach the limitations of the pending claims because there is no indication in the reference as to the desirability of making such modifications. The cited reference must disclose the desirability of making the proposed modification.<sup>5</sup> The fact that the modification is possible or even advantageous is not enough.<sup>6</sup> A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.<sup>7</sup>

With respect to the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combination. The combination of *Vandette* and the proffered judicial notice would not be capable of performing the operations required by the claimed invention. For example, there is no showing by the Examiner that the teachings of *Vandette* could provide the wireless operations of the claimed architecture. Imparting the teachings of a wired network into a wireless configuration is tenuous and highly speculative. The proposed combination (presumptively) attempts to combine divergent subject matter (wired vs. wireless) that has not been shown to be capable of operating according to any degree of predictability. The Examiner, without resorting to improper hindsight to look through the claimed invention, has not addressed the chance that

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<sup>3</sup> In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Conclusory statements by the Examiner regarding the teaching of multiple references, standing alone, are not "evidence." *Id.*

<sup>4</sup> See M.P.E.P. §2145. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to lack of suggestion in the prior art of the desirability of combining references."); see also *In re Jones*, 958 F.2d 347 ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].")

<sup>5</sup> *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990).

<sup>6</sup> See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

<sup>7</sup> *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). (See also M.P.E.P. §2141.02).

the proposed combination would have any success whatsoever: let alone a reasonable expectation of success as is required. Therefore, Applicant respectfully submits that the Examiner has failed to establish the second criteria for a prima facie case of obviousness.

With respect to the third criterion of non-obviousness, the Examiner has not shown how the proposed combination teaches each and every limitation of the claimed invention. This has been evaluated thoroughly by the Applicant in the tendered analysis provided supra. Moreover, there are other shortcomings of *Vandette* (not necessarily addressed herein) that preclude it from inhibiting the patentability of the pending claims.

For at least this reason, Independent Claim 1 is patentable over the proposed combination. Additionally, Independent Claims 11, 21, 31, 41, 49, and 57 recite a limitation that is similar to that identified above and are, therefore, also patentable over the proposed combination for similar reasons. In addition, the corresponding dependent claims of these Independent Claims are also allowable for analogous reasons.

Therefore, Applicant respectfully submits that claims 1-65 are patentably distinct from the proposed combinations. All of the pending claims have been shown to be allowable, as they are patentable over all of the references of record. Notice to this effect is respectfully requested in the form of a full allowance of claims 1-65.

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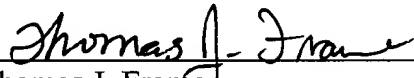
CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes that no fee is due. If, however, this is not correct, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Thomas J. Frame, at (214) 953-6675.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorneys for Applicant

  
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Thomas J. Frame  
Reg. No. 47,232

Date: October 4<sup>th</sup>, 2004

Customer No. **05073**